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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/647,505 | 08/26/2003 | Anthony Sgroi JR. | 618-1170-999 | 2713 |
| 20582 | 7590 | 02/23/2005 | EXAMINER | |
| JONES DAY 51 Louisiana Avenue, N.W. WASHINGTON, DC 20001-2113 | | | BASICHAS, ALFRED | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3749 | |

DATE MAILED: 02/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | |
|------------------------------|----------------------------|------------------------|
| Office Action Summary | Application No. | Applicant(s) |
| | 10/647,505 | SGROI ET AL. <i>CB</i> |
| | Examiner Alfred Basicas | Art Unit 3749 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 04 January 2005.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-75 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-75 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Terminal Disclaimer

The Terminal Disclaimer filed January 4, 2005, has not been approved for the following reasons:

An attorney or agent, not of record, is not authorized to sign a terminal disclaimer in the capacity as an attorney or agent acting in a representative capacity as provided by 37 CFR 1.34 (a). See 37 CFR 1.321(b) and/or (c).

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Omum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-75 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-41 of U.S. Patent No. 6,726,469. Although the conflicting claims are not identical, they are not patentably distinct from each other because the general scope of the

invention claimed are the same. The general scope of the claims involves an actuator with plural positions corresponding to plural force/pressure required to ignite the fuel. Whether the claims simply recite varying the force/pressure required between the positions of the actuator, whether the claims specifically recite a high and low pressure mode, or whether the claims recite a specific amount of force required, the differences would not be unobvious to one of ordinary skill in the art at the time of invention.

3. Claims 1-75 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-52 of U.S. Patent No. 6,491,515. Although the conflicting claims are not identical, they are not patentably distinct from each other because the general scope of the invention claimed are the same. The general scope of the claims involves an actuator with plural positions corresponding to plural force/pressure required to ignite the fuel. Whether the claims simply recite varying the force/pressure required between the positions of the actuator, whether the claims specifically recite a high and low pressure mode, or whether the claims recite a specific amount of force required, the differences would not be unobvious to one of ordinary skill in the art at the time of invention.

4. Claims 1-75 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-52 of U.S. Patent No. 6,488,492. Although the conflicting claims are not identical, they are not patentably distinct from each other because the general scope of the invention claimed are the same. The general scope of the claims involves an actuator with plural positions corresponding to plural force/pressure required to ignite the fuel. Whether the claims simply recite varying the force/pressure required between the positions of the actuator, whether the claims specifically recite a high and low pressure mode, or whether the claims recite a specific amount of force required, the differences would not be unobvious to one of ordinary skill in the art at the time of invention.

5. Claims 1-75 provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-19 of copending Application No. 10/788,195. Although the conflicting claims are not identical, they are not patentably distinct from each other because the general scope of the invention claimed are the same. The general scope of the claims involves an actuator with plural positions corresponding to plural force/pressure required to ignite the fuel. Whether the claims simply recite varying the force/pressure required between the positions of the actuator,

whether the claims specifically recite a high and low pressure mode, or whether the claims recite a specific amount of force required, the differences would not be unobvious to one of ordinary skill in the art at the time of invention.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

6. Claims 1-75 provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-69 of copending Application No. 10/398,975. Although the conflicting claims are not identical; they are not patentably distinct from each other because the general scope of the invention claimed are the same. The general scope of the claims involves an actuator with plural positions corresponding to plural force/pressure required to ignite the fuel. Whether the claims simply recite varying the force/pressure required between the positions of the actuator, whether the claims specifically recite a high and low pressure mode, or whether the claims recite a specific amount of force required, the differences would not be unobvious to one of ordinary skill in the art at the time of invention.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alfred Basichas whose telephone number is 703 306 3476. The examiner can normally be reached on Monday through Friday during regular business hours.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ira Lazarus can be reached on 703 308 1935. The fax phone numbers for the organization where this application or proceeding is assigned are 703 872 9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 308 0861.

February 18, 2005



Alfred Basichas
Primary Examiner
703 306 3476